

UTILITY PATENT

B&D No. TN-1444A

The Examiner rejected Claims 17-19, 43 and 45 under 35 USC § 103(a) as being unpatentable over US 4,870,702 ("Azzouni") in view of US Patent No. 5,633,096 ("Hattori").

This rejection is respectfully traversed.

Claim 17 calls for a method for charging a battery pack comprising providing an audio equipment component having a power supply, a circuit for producing an audio signal connected to the power supply and a charger connected to the power supply, disposing the battery pack in the charger, providing power to the battery pack, and removing the battery pack from the charger. Claim 43 calls for an apparatus comprising a housing, an audio circuit for producing an audio signal disposed in the housing, a charger disposed in the housing, a receptacle in the charger, a battery pack detachably connectable in a power tool mounted in the receptacle, a first electrical circuit in the charger for charging the battery pack and for powering the audio circuit, and a connector for connecting the first electrical circuit to a power source.

As admitted by the Examiner, Azzouni does not disclose a method where a battery pack is disposed in and removed from the charger. The Examiner relies instead on Hattori to provide the missing elements. However, Hattori does not disclose disposing a battery pack in and removing it from the charger. Instead, it discloses installing a battery pack in a holder housing, not in a charger.

Azzouni and Hattori however cannot be combined as no prima facie case of obviousness exists. According to MPEP § 2142, to establish a prima facie case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally

available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. MPEP § 2142, at 2100-121.

In the present case, no suggestion to combine or modify Azzouni with Hattori exists because the modification would change the principle of operation of Hattori. “If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.” MPEP § 2143.01, at 2100-125 (*citing In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)).

According to the Examiner, he relies on Azzouni for the “housing, charger and radio circuit,” as well as a rechargeable battery. As admitted by the Examiner, Azzouni “is silent as to the possibility of removing the battery.” The Examiner relies on Hattori to teach that a battery can be disposed in a device other than a power tool.

However, Hattori teaches disposing the battery pack into a housing 1, which is then connected to a non-power tool device, rather than connecting the battery pack directly into the non-power tool device. Accordingly, the Examiner is modifying Hattori in such a way that he changes Hattori’s principle of operation, i.e., connecting the battery pack into a housing, which is then connected to a non-power tool device. Because of this, no suggestion to modify exists under MPEP § 2143.01. Thus, “the teachings of the references are not sufficient to render the claims *prima facie* obvious” under MPEP § 2143.01.

Therefore, Azzouni and Hattori cannot be combined to render Claims 17-19 and 43-45 unpatentable.

In addition, the Applicant respectfully submits that objective evidence of market success supports the conclusion that the present invention is not obvious in view of Azzouni and Hattori.

In particular, the Applicant began selling the DeWalt DW911 Heavy-Duty Worksite Radio/Charger ("the Radio Charger") in the second quarter of 1999 (Exhibit A, paragraph 5). The Radio Charger contains all of the elements of the present invention as recited in Claims 17-20 and 43-45 (Exhibit B). The Radio Charger has sold approximately 500,000 units from its introduction to October 31, 2001. (Exhibit A, paragraph 6). Accordingly, the total sales in that time period is almost \$54 million dollars. (*Id.*) These sales are expected to increase due to the 2001 holiday season. (*Id.*) Because no other radio charger for charging power tool battery packs has been introduced in Black & Decker's major sales channels, and possibly anywhere else, Black & Decker's share in the market of radio chargers for charging power tool battery packs is 100%. (Exhibit A, paragraph 7).

The commercial success of the Radio Charger is attributable to the claimed invention, as evidenced by the attached declarations of Messrs. John Vargo and John Ziganto. Further evidence of such nexus can be found in the many articles and reviews attached hereto, which highlight the radio's ability to charge a power tool battery pack as the most important feature of the product.

Given the foregoing, the Applicant respectfully submits that the substantial market success of products incorporating the present invention is directly related to the invention as claimed and that this success supports the conclusion that the invention was not obvious to one of ordinary skill in the art at the time the invention was conceived.

In addition to market success, the Radio Charger has received wide recognition in the power tool industry. This recognition also supports Applicant's position that the present invention is novel and non-obvious.

Applicant hereby attaches assorted articles and reviews on the Radio Charger. In all of them, the ability to charge power tool battery packs in the radio is highlighted as the most important feature of the product.

For example, the Pennsylvania Housing Research Center (PHRC) discussed the Radio Charger in its newsletter, the PHRC News. The newsletter reads as follows: "DeWalt Industrial Tool Company is introducing a job-site-radios [sic] with a difference. The radio is made of the same black and yellow impact-resistant plastic as their tools; it has a roll-bar to protect it; the knobs are oversized so they can be used by hands with work gloves on; and it can run off either line voltage or a DeWalt battery pack. **But get this.** If you are using 120 volt line power, it serves as a battery charger. It will charge **any** voltage battery pack that DeWalt makes (9.6V to 18V)." (Bold emphasis in original.)

A tool review website (asktooltalk.com) featured the Radio Charger at <http://www.toolreviews.net/home/reviews/electricalproducts/dw911.htm>. The review begins by explaining the need for this Radio Charger:

Nothing is more discouraging than to have a battery on your cordless tool die—just as you near the end of your project. Even worse is to reach for your spare (if you have one) only to find it dead because you forgot to charge it. It's terrible that we have become so reliant on cordless tools that we forget that somewhere a corded tool is buried in a toolbox that would complete the project. What do you do? My guess is that you'll reach for the charger and wait an hour for the battery to recharge. Why not charge it with a little class? How about a listening to your favorite radio station while the battery does its thing? Well, now you can!

The review then tells how the Radio Charger meets that need with its main feature, i.e., a radio that charges power tool battery packs:

DeWalt has just came out with a worksite radio/charger combination that does just that—charges batteries and plays your favorite radio station. This product is unbelievable. The AM-FM full-stereo radio delivers sound that could easily match a full-blown stereo system. What makes this unit different from other radios on the market is that DeWalt has combined the technology of a three-stage charging system with a radio which can run off AC, a portable generator, or up to 12 hours on a single battery (their own make).

Similarly, the Amazon.com/Tool Crib of the North editors wrote of the Radio Charger that it “not only rocks the house, it also charges your 7.2- to 18-volt ni-cad batteries in just one hour.” (http://www.amazon.com/exec/obidos/ASIN/B0000222ZW/qid=1008604737/sr=1-1/ref=sr_1_14_1/107-3275248-6364518)

The Radio Charger was also featured in the February 1999 issue of the Building Material Dealer magazine. The article reads in relevant portion: “The DW911 from DeWalt functions both as a charger for the entire line of DeWalt NiCD battery packs as well as a heavy-duty radio, durable enough to withstand demanding worksite conditions. When plugged into an AC outlet, it recharges all DeWalt 9.6 volt to 18 volt NiCD battery packs in less than one hour while simultaneously functioning as a radio.”

In addition to recognition within the power tool industry, the Radio Charger has received wide recognition outside the power tool industry. This recognition also supports Applicant’s position that the present invention is novel and non-obvious.

The online version of New York magazine (newyorkmetro.com) features the Radio Charger as a “Best Bet.” In particular, the website describes how to use the Radio Charger:

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“Simply place the DeWalt battery pack in the back of the radio, and it will charge in about an hour.” (http://www.nymag.com/page.cfm?page_id=4436). In addition, it appears that this article appeared in the March 12, 2001, issue of New York magazine. However, Applicant does not have a copy of such issue.

The Miami Herald, a Florida daily newspaper, featured the Radio Charger in the February 14, 1999 edition, as one of the products that “stood out” at the 1999 International Builders Show in Dallas. In particular, the author wrote: “What do you get when you cross a radio with a battery charger? The DW911 by DeWalt ... This heavy-duty product, designed for professional tradesmen, functions as both a radio and a charger, which can recharge the entire line of DeWalt battery packs.”

The online edition of Popular Mechanics (popularmechanics.com) features the Radio Charger in an archived article. In particular, the article reads: “Leave it to engineers at the industrial tool company DeWalt to come up with a radio that can survive a construction accident. It also comes with a battery charger. The DeWalt DW911 hybrid radio/charger (\$149) rejuices all DeWalt nickel-cadmium battery packs from 9.6 to 18 volts for the company's line of cordless power tools.” The article can be found at

http://www.popularmechanics.com/technology/audio/2000/2/_Rough_And_Tough_Gear/.

It appears that this article could have been present in the February 2000 print edition of Popular Mechanics. However, Applicant does not have such issue.

In the February 13, 1999 edition of the Appleton Post-Crescent, a Wisconsin daily newspaper, the Radio Charger was featured in the Home Trends section of the newspaper. In

particular, the paper read: "DeWalt Tools has come up with a way to recharge power tool batteries and listen to music at the same time."

The publications cited above thus establish that the Radio Charger has received wide recognition, both in the power tool industry and outside the power tool industry, because of its ability to charge power tool batteries. (Indeed, this recognition was well-deserved as the attached declarations of Messrs. John Vargo and John Ziganto show that providing a radio with the ability to charge power tool batteries was an important feature for end users.) Accordingly, the publications provide clear, objective evidence that strongly supports the conclusion that the present invention was not obvious to one of ordinary skill in the art at the time it was made.

The Examiner also rejected Claims 20 and 44 under 35 USC § 103(a) as being unpatentable over Azzouni in view of Hattori and further in view of US Patent No. 4,709,201 ("Schaefer"). This rejection is respectfully traversed.

Claims 20 and 44 are ultimately dependent upon Claims 17 and 43, respectively. As such, they include all the elements of their respective independent claims. As mentioned above, the Azzouni-Hattori combination does not disclose "disposing the battery pack in the battery charger ... and removing the battery pack from the charger" and "a charger disposed in the housing, a receptacle in the charger, [and] a battery pack ... mounted in the receptacle" as called for in Claims 17 and 43, respectively. Schaefer does not disclose such elements. Therefore, the Azzouni-Hattori-Schaefer combination does not include all the claimed elements and thus cannot render Claims 20 and 44 unpatentable.

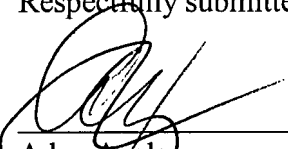
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In view of the foregoing, all the claims are patentable and the application is believed to be in condition for formal allowance. Reconsideration of the application and allowance of Claims 17-20 and 43-45 are respectfully requested.

The Commissioner is authorized to charge payment of a one-month extension fee (\$110.00), as well any other fees due in processing this response, or credit any overpayment to Deposit Account No. 02-2548.

Respectfully submitted,



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